UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,338	07/27/2001	Hiroyuki Nishi	4777/2	1880

29540 7590 01/26/2006

PITNEY HARDIN LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

EXAMINER
MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/917,338	NISHI ET AL.	
	Examiner	Art Unit	
	Steven B. McAllister	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-38* is/are pending in the application.

4a) Of the above claim(s) *10-24 and 31-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether claims 25-30 are intended to be apparatus claims or method claims. The preamble appears to recite a method, but the body of the claim recites apparatus elements (a means for managing identifiers, a means for storing computation formulas). Further, no method step is positively recited. Rather, the body recites "an identifier step *for*...", "a formular obtaining step *for* ...", and "a step *for* ...". In light of the lack of positively recited method steps, the positively recited apparatus elements, and the fact that "which comprises" of line 2 could be construed to refer to either the method or the charge processing system, it is not clear what the intended scope of the invention is.

Assuming that claims 25-30 are intended to be method claims, claims 25-30 provide for the use of an accounting system, but, since the claim does not positively set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. It is noted that claim 6 recites "an accounting fee calculation step for" but no step is ever

positively recited; rather intended use of the step comprising the "for calculating an accounting fee..." is provided.

Assuming that claims 25-30 are intended to be apparatus claims, the apparent steps for achieving certain tasks are not further limiting, since they are not elements of the apparatus, but how the apparatus might be used.

Claim 28 is indefinite because "computes a charge for an installation of said button in respect to the administrator" is unclear.

Claim 30 is indefinite because it recites that the electronic appliance is video RAM and/or a network interface. The specification appears to show that the apparatus comprises these features, not that it is one. Additionally, and/or further makes the claim indefinite.

Also, to the extent that claim 30 depends from claim 20, which is withdrawn, it is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-30 are rejected (to the extent they are assumed to be intended to be method claims) under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.

See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Melo et al (2001/0037270).

Melo shows an identifier managing means, means storing charging formulas, obtaining a administrative identifier of the device (printer or copier), obtaining the formula for charging, and computing a charge with the formula based on the information from the appliance.

Claims 25, 27, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Oren et al (6,240,401).

Oren shows an identifier managing means, means storing charging formulas, obtaining a administrative identifier of the device (the dvd playing device), obtaining the

formula for charging, and computing a charge with the formula based on the information from the appliance.

As to claim 27, the apparatus of Oren implements a plurality of functions (e.g., display of DVD over a set period of time, or display of the DVD a single time, or free display after purchase – col. 5, line 50-65), the identifier identifying a sub-system implementing a function and calculating based on the identifier.

Claims 25, 27, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura (6,144,946).

Iwamura shows an identifier managing means, means storing charging formulas, obtaining a administrative identifier of the device, obtaining the formula for charging, and computing a charge with the formula based on the information from the appliance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26- 28 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Melo.

As to claims 26 and 30, Melo shows all elements except the particular type of device that the appliance is. However, the examiner takes official notice that to provide

a device that is a display device, video ram, or a network interface is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Melo to provide such an apparatus since the method can be used with any type of apparatus.

As to claim 27, Melo shows all elements of the claim except providing a multi-function appliance, providing identifiers for different subsystems of the system and calculating a charge based on the identifiers associated with the subsystems. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Melo by providing the recited elements in order to facilitate different charges for different tasks.

As to claim 28, Melo shows all elements except remote control, providing an identifier for the remote control and charging based on the use of the remote control. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to provide the recited elements in order to more accurately provide for charging.

Claims 26- 28 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Oren.

As to claims 26 and 30, Oren shows all elements except the particular type of device that the appliance is. However, the examiner takes official notice that to provide a device that is a display device, video ram, or a network interface is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Oren to provide such an apparatus since the method can be used with any type of apparatus.

As to claim 27, Oren shows all elements of the claim except providing a multi-function appliance, providing identifiers for different subsystems of the system and calculating a charge based on the identifiers associated with the subsystems. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Oren by providing the recited elements in order to facilitate different charges for different tasks.

As to claim 28, Oren shows all elements except remote control, providing an identifier for the remote control and charging based on the use of the remote control. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to provide the recited elements in order to more accurately provide for charging.

Response to Arguments

Applicant's arguments with respect to the claim have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister
Primary Examiner
Art Unit 3627

Steven B. McAllister

STEVE B. MCALLI
PRIMARY EXA